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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,523	04/23/1999	DAVID E. BRILES	454312-3140	2114

7590 09/08/2004
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EXAMINER

MINNIFIELD, NITA M

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/298,523

Applicant(s)

BRILES ET AL.

Examiner

N. M. Minnifield

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-42 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) 28-33, 35-41 and 44-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 28-33, 35-41 and 44-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/26/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicants' amendment filed June 4, 2004 is acknowledged and has been entered. Claims 1-27 and 43 have been canceled. Claims 34 and 42 have been amended. Claims 34 and 42 are now pending in the present application. All rejections have been withdrawn in view of Applicants' amendment and/or comments with the exception of discussed below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 28-33, 35-41 and 44-47 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 28.
4. Claims 34 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 34 and 42 are vague and indefinite in the recitation of "an amino acid sequence" and "an amino acid sequence comprising SEQ ID NO: 13" respectively; does Applicant intend the whole of SEQ ID NO: 13 or any portion of the amino acid sequence as set forth in SEQ ID NO: 13? This is not clear.

This rejection is maintained for the reasons set forth in the above paragraph.

5. It is noted that the claimed invention has an effective filing date of April 23, 1999, the filing date of the pending application 09/298523. Applicants have provided CIP applications 08/529055 and 08/714741; however the claimed invention is not disclosed in either of these applications. CIP application 08/529055, now US Patent 6592876, does not disclose PspC; this patent only discloses PspA. No amino acid sequences for PspC are disclosed. CIP application 08/714741, now US Patent 6500613, discloses PspC but does not disclose the complete amino acid sequence as set forth in SEQ ID NO: 13. The sequence search results (see attached printout) indicate only a 77% match with the claimed amino acid sequence of SEQ ID NO: 13. The results indicate that SEQ ID NO: 40 of 6500613 is a 77% match with amino acids 263-442 of SEQ ID NO: 13 and only 47% match with the complete 511 amino acid sequence of SEQ ID NO: 13. Further, it is noted that the provisional application, 60/082728, was April 23, 1998; however, this provisional application is not in sequence compliance. The effective filing date of the current application is April 23, 1999, the filing date of 09/298523. This non-provisional application fails to comply with the sequence rules. Should Applicants desire priority back to the provisional application (60/082728), Applicants should set forth where support can be found in the provisional application for the claimed sequences.

6. Claims 34 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Choi et al (6573082), Wizemann et al (6503511) or Hostetter et al (6291654).

Choi et al (6573082) discloses SEQ ID NO: 13 (see SEQ ID NO: 6).

Wizemann et al (6503511) discloses SEQ ID NO: 13 (see SEQ ID NO: 6, 9 and 16).

Choi et al (6573082) discloses SEQ ID NO: 13 (see SEQ ID NO: 38 and 41).

The prior art discloses the claimed isolated polypeptide. Each reference discloses the claimed PspC from the same source as Applicants' isolated and purified polypeptide. Since the Patent Office does not have the facilities for examining and comparing applicants' polypeptide with the polypeptide of the prior art reference, the burden is upon applicants to show a distinction between the material structural and functional characteristics of the claimed polypeptide and the polypeptide of the prior art. See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

The prior art rejections are maintained for the reasons of record. Applicant's arguments filed June 4, 2004 have been fully considered but they are not persuasive.

Applicants have asserted that since none of the cited references teaches the specific nucleic acid sequence of SEQ ID NO: 13, as recited in the amended claims, the rejection under 35 U.S.C. 102(e) should be withdrawn.

However, the claims recite "polypeptide has an amino acid sequence..." which is not necessarily the entire amino acid sequence of SEQ ID NO: 13, but a portion or fragment of the sequence which the prior art discloses. The Examiner has interpreted the claims as broadly as possible.

7. No claims are allowed.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is 571-272-0860. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette R.F. Smith can be reached on 571-272-0864. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1645

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, appearing to read "N. M. Minnifield".

N. M. Minnifield

Primary Examiner

Art Unit 1645

NMM

September 2, 2004